

AMENDMENT UNDER 37 C.F.R. § 1.111
APPLICATION NO. 09/707,963
ATTORNEY DOCKET NO. Q61597

REMARKS

Claims 1-25 are all the claims pending in the application. By this Amendment, Applicant editorially amends claims 1-3, 5, 6, 8, 10, 11, 18 and 19. The amendments to claims 1-3, 5, 6, 8, 10, 11, 18 and 19 were made for reasons of precision of language and consistency, and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 1-3, 5, 6, 8, 10, 11, 18 and 19 were not made for reasons of patentability.

In addition, by this amendment, Applicant adds claims 20-25. Claims 20-25 are clearly supported through out the Specification and no new matter is being added.

Preliminary Matters

Applicant thanks the Examiner for acknowledging the claim to foreign priority and for confirming that the certified copy of the priority document was received. In addition, Applicant also thanks the Examiner for initialing the references listed on Form PTO-1449 submitted with the Information Disclosure Statement filed on November 8, 2000.

The Examiner has objected to claim 6 because of minor informality. Applicant has revised the claim, and respectfully submits that the claim as now presented no longer include the potential informality mentioned by the Examiner. Applicant, therefore, respectfully requests the Examiner to withdraw this objections to the claim.

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Claim Rejections

The Examiner rejected claims 1, 3-9, 12-14, 16 and 18-19 under 35 U.S.C. § 102(b) as allegedly being anticipated by USP 5,978,667 to Suzuki et al. (hereinafter "Suzuki"). Furthermore, the Examiner rejected claims 2, 10, 15 and 17 under 35 U.S.C. § 103(a) as allegedly being obvious in view of Suzuki and Applicant's prior art admission (hereinafter "Admitted Prior Art"). Finally, claim 11 is rejected under 35 U.S.C. § 103(a) as allegedly obvious in view of Suzuki, Admitted Prior Art and USP 6,125,285 to Chavez, Jr. et al. (hereinafter "Chavez"). Applicant respectfully traverses these rejections for at least the reasons discussed below.

Rejections under 102

The Examiner rejected claims 1, 3-9, 12-14, 16 and 18-19 under 35 U.S.C. § 102(b) as allegedly being anticipated by Suzuki. Of these claims only claims 1 and 12 are independent; therefore, this response focuses initially on claims 1 and 12. Claim 1 recites a novel combination of features not taught by the cited reference. For example, claim 1 recites wherein said specific multifunction telephone notifies said control unit of a call arrival at said portable radiophone.

The Examiner alleges that Suzuki's teaching of a portable station transmitting a call arrival to the control unit when the multifunction telephone is coupled to a portable phone is equivalent to the specific multifunction telephone notifying the control unit of a call arrival at the portable radiophone as set forth in claim 1 (see page 3 of the Office Action). Applicant respectfully disagrees with the Examiner.

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To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

For example, an illustrative, non-limiting embodiment of the present invention discloses that a coupling unit 16 connects the portable phone with the multifunctional phone (e.g., wire phone). This coupling unit 16 converts the signal received at the portable phone to the one acceptable by the multifunctional phone so that multifunctional phone can pass this signal to the control unit (for example, to notify the control unit of a call to the portable phone via multifunctional phone), see e.g. Figs. 4 and 5, pages 21-25. One of ordinary skill in art knows that a wired telephone cannot transmit information to the control unit via radio communication mode; as a result, the coupling unit converts the signal received at the portable phone. Alternatively, the multifunction phone may have a unit for converting this received signal.

Suzuki teaches making a wired extension telephone set compatible with portable stations (col. 3, lines 4 to 15). In particular, Suzuki teaches an electronic exchange system wherein multifunctional wired phones 120 are connected to a conventional PBX 110 (which has a controller) via wired lines 119. Moreover, this electronic exchange system has portable stations 170 also connected to a conventional PBX 110 via cell stations 150, which receive the signal

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from the portable stations 170 and forward this signal to the PBX 110 via interface lines 117 (Fig. 1 and 21; col. 7, lines 7 to 35).

In an alternative embodiment, Suzuki teaches a wired telephone 320 connected to a position detector 380, which in turn is connected to a placing station 381 and a portable station 370. The position detector 380 detects whether the portable station 370 is in a placing section 381. If the portable station 370 is in the placing station 381, this information is sent to the PBX via the wired telephone 320. Once the PBX receives this information, it is stored in a table correlating the extension of the portable phone to the extension of the wired phone. In addition, this table stores a flag whether the call to the portable phone should be sent to the wired phone instead.

However, Applicant respectfully point out that upon receipt of a call at the portable station 370, a radio signal is sent to the PBX 110 via a cell station 150 and interface circuit 116. That is, Suzuki teaches that all calls are conventionally transmitted to the PBX, which decides where to route the call based on data stored in a form of a table in the PBX's storage section. In other words, Suzuki teaches transmitting calls from a portable phone to the PBX via radio communication and transmitting a call from a wired telephone to the PBX via wire lines.

The Examiner acknowledges that the reception information is radio transmitted (see page 3 of the Office Action; col. 10, lines 31 to 46 of Suzuki). Therefore, in order to somehow meet the recitation of a multifunctional telephone notifying the control unit of a call arrival at the portable station as set forth in claim 1, the Examiner alleges that Suzuki's portable station (which

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is a wired terminal coupled to a portable phone) is equivalent to the multifunction phone as set forth in claim 1 (page 3, lines 9-10 of the Office Action).

Although such interpretation is technically inaccurate, even *assuming arguendo* that a multifunction phone as set forth in claim 1 is somehow similar to a portable station, then Suzuki fails to teach or suggest a multifunction telephone connected to said portable radiophone as set forth in claim 1. That is, if the Examiner asserts that Suzuki's portable phone is part of the multifunction phone, then Suzuki fails to teach or suggest a multifunction phone connected to a portable phone. On the other hand, if portable phone is not part of a multifunction phone, then Suzuki fails to teach or suggest informing the control unit of a call arrival at the portable phone via multifunction phone.

In short, in Suzuki, the arrival of a call to a portable station is conventionally radio transmitted to the PBX 110 via cell station 150. In Suzuki, calls are rewired by consulting a table which correlates a portable phone extension to a wired phone extension and in some instances (based on the flag), transmits the call to the extension of the wired phone as opposed to the extension of the of the radio station.

Therefore, *specific multifunction telephone notifies said control unit of a call arrival at said portable radiophone* as set forth in claim 1 is not suggested or taught by Suzuki, which lacks notifying the control unit of a call arrival to a portable phone via a multifunction telephone. For at least these reasons, Applicant respectfully submits that independent claim 1 is patentably distinguishable from Suzuki. Applicant, therefore, respectfully requests the Examiner

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to reconsider and withdraw this rejection of independent claim 1. Also, Applicant respectfully submits that claims 3-9 are allowable at least by virtue of their dependency on claim 1.

Next, Applicant respectfully traverses this rejection with respect to the independent claim 12, which has a number of unique features not taught by the cited reference. For example, claim 12 has a multifunction telephone with a communication control section which detects a call arrival at said portable radiophone. This recitation is somewhat similar to the recitation of multifunctional telephone notifying the control unit of a call arrival to the portable telephone as set forth in claim 1. Since claim 12 contains features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here.

Moreover, Applicant respectfully point out that the Examiner's interpretation that a handset as set forth in claim 12 corresponds to Suzuki's wired telecommunication terminal 320 and that Suzuki's detector corresponds to communication control section are technically inaccurate. Suzuki teaches multifunctional telephones 120 (120-1 to 120-i) of wired extension terminals (Fig. 1; col. 7, lines 11 to 13). In a third embodiment, Suzuki teaches that this wired telephone 320 (which is fundamentally similar to the structure of the first embodiment) is connected to a portable station position detector 380 (Figs. 21 and 22; col. 22, lines 43 to 64) for detecting the presence or absence of a portable station and informing the results to the electronic exchange system 310 (col. 23, lines 5 to 12). Position detector 380 is an apparatus (col. 23, lines 20 to 25).

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In short, Suzuki's position detector is clearly separate from the multifunctional telephone. Moreover, Suzuki's position detector fails to detect a call arrival at the portable phone, instead it only detects the presence or absence of a portable phone on a placing station 281. Finally, the position detector does not control wired line or radio channel communication, it only detects the absence or presence of a portable phone. For at least these reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of independent claim 12 and its dependent claims 13-14, 16 and 18-19.

Rejections under 103

The Examiner rejected claims 2, 10, 11, 15 and 17 under 35 U.S.C. § 103(a). Applicant respectfully traverses this rejection and requests the Examiner to reconsider in view of the following comments.

Claims 2, 10, 15 and 17 are rejected as allegedly being obvious in view of Suzuki and Applicant's Admitted Prior Art. Claims 2 and 10 depend on claim 1 and claims 15 and 17 depend on claim 10. Applicant has already demonstrated that Suzuki does not meet all the requirements of independent claims 1 and 12. Applicant's Admitted Prior Art clearly fails to cure the deficient teachings of Suzuki. In short, the combination of Suzuki and Applicant's Admitted Prior Art does not teach or suggest a multifunction telephone notifying the control unit of a call arrival to said portable phone as recited in claims 1 and 12. None of the references, either alone or in combination, teach or suggest recitations of these independent claims.

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Dependent claims 2, 10, 15, 17 are patentable at least by virtue of their dependency on claim 1 or 12.

Claim 11 stands rejected as allegedly being obvious over Suzuki in view of Applicant's Admitted Prior Art and further in view of Chavez. Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claim 11. Applicant has already demonstrated that Suzuki and Applicant's Admitted Prior Art do not meet all the requirements of independent claim 1. Chavez only teaches a wireless telecommunication system between a wireless terminal and auxiliary desktops. Not only does it fail to cure the deficient teachings of Suzuki and Applicant's Admitted Prior Art but there is also no motivation to combine the references in the manner suggested by the Examiner.

One of ordinary skill in the art confronted with a problem of having to respond to both a portable phone and a wired phone would not have turned to Chavez, which only teaches wireless communication and inserting wireless terminals into an auxiliary desktop. It is simply in a different field of endeavor and addresses a different problem. None of the references, either alone or in combination, teach or suggest recitations of this independent claim 1. Dependent claim 11 is patentable at least by virtue of its dependency on claim 1.

New Claims

Applicant herein adds new claims 20-25. Applicant respectfully submits that claim 20 is allowable at least by virtue of a recitation of a multifunction telephone switching from a wired line communication mode to a radio communication mode to answer a call addressed to a

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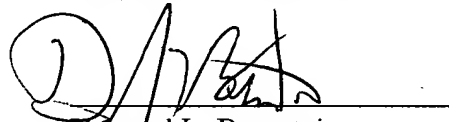
portable phone via handset of the multifunction telephone. Claims 21-25 are patentable at least by virtue of their dependency on claim 20.

Conclusion and request for telephone interview.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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